

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 2451 : PATENT APPLICATION
Examiner Backhean Tiv :
In re application of :
THOMAS LEDERER ET AL. : DEVICE AND METHOD FOR USER-BASED
Serial No. 10/563,489 : PROCESSING OF ELECTRONIC MESSAGE
: COMPRISING FILE ATTACHMENTS
Filed January 3, 2006 :
Confirmation No. 8264 :

AMENDMENT

Pittsburgh, Pennsylvania 15219

July 22, 2010

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Please amend this application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 8 of this paper.

Amendments to the Claims

This listing of claims will replace all prior versions, and listings, of claims in the application:

1-11. (Canceled)

12. (Currently Amended) A method for processing an electronic message comprising:
receiving an electronic message, the electronic message comprised of at least one file attachment;

opening the electronic message;

saving the at least one file attachment in a user-selected memory location;

creating a link to the electronic message;

saving the link to the electronic message in the user-selected memory location.

replacing the at least one file attachment in the electronic message with at least one first link when the at least one file attachment is saved, the at least one first link configured to display the at least one file attachment after the at least one first link is actuated;

creating a second link to the electronic message when the at least one file attachment is saved; and

saving the second link to the electronic message in the user-selected memory location when the at least one file attachment is saved.

13. (Currently Amended) The method according to claim 12 wherein the user-selected memory location is a file and the second link is created and saved such that the second link is

displayed in the ~~same file as the file attachment~~, file, the second link configured to display the electronic message after the second link is actuated.

14. (Currently Amended) The method according to claim 13, wherein the at least one file attachment has a file name that is changed when the at least one file attachment is saved.

15. (Currently Amended) The method according to claim 14, wherein the second link is comprised of a name that is comprised of the changed file name.

16. (Previously Presented) The method according to claim 12 wherein the electronic message is an e-mail of an SMTP e-mail client.

17. (Previously Presented) The method according to claim 12, wherein the at least one file attachment is saved according to a defined rule and/or in a set file structure.

18. (Previously Presented) A device for user-based processing of at least one electronic message, the device comprising:

an e-mail client configured to receive at least one electronic message having a file attachment;

an attachment substitution unit configured to replace a file attachment of a received electronic message with a memory location link after user input is received that requires the file attachment to be saved and linked; link;

a user file system configured to store the file attachment;

an attachment insertion unit configured to insert the replaced file attachment in a selected memory location in a file system after the user input is received that requires the file attachment to be saved and linked; system;

a message link insertion unit configured to insert a message link in the selected memory location when the attachment is stored in the selected memory location and the user input requires the file attachment to be saved and linked, location, the message link referring to the electronic message; and

a control unit configured to control the e-mail client, the attachment substitution unit, the message link insertion unit and the attachment insertion unit.

19. (Currently Amended) The device according to claim 18 wherein the selected memory location is a file in the file system and the message link is created and saved such that the message link is displayed in that file, the same file as the file attachment, the message link configured to display the electronic message after the message link is actuated.

20. (Previously Presented) The device according to claim 19, wherein the message link is comprised of a file name of the inserted file attachment

21. (Currently Amended) The device according to claim 18, wherein the attachment insertion unit is configured to automatically file the replaced file attachment using a modified file name.

22. (Currently Amended) The device according to claim 21, wherein the attachment insertion unit files the replaced file attachment according to a user-defined ~~user-defined~~ rule and/or a user-define file structure.

23. (Currently Amended) The method of claim 12 ~~further comprising replacing the at least one file attachment with at least one the at least one first link is an attachment link, link in the electronic message.~~

24. (Previously Presented) The method of claim 12 wherein the user-selected memory location is a hard disk of a telecommunications terminal or a memory accessible via a network.

25. (Currently Amended) The method of claim 12 wherein the second link is a backlink.

26. (Previously Presented) The method of claim 12 wherein the user-selected memory location is a file of a file system, the file system stored on and/or maintained by an electronic device selected from the group consisting of computers, telecommunications terminals and networks.

27. (Previously Presented) The device of claim 18 wherein the message link is a backlink.

28. (Previously Presented) The device of claim 18 wherein the user-selected memory location is a file of a file system, the file system stored on and/or maintained by an electronic device selected from the group consisting of computers, telecommunications terminals and networks.

29. (Currently Amended) The device of claim 18 wherein the selected memory location is a file of a file system and the message link insertion unit is configured to insert a message link in the file selected memory location such that the message link is displayed in the same file along with as the file attachment, the message link configured to display the electronic message after the message link is actuated.

30. (Currently Amended) The device of claim 18 wherein the message link insertion unit is comprised of a backlink generation apparatus. means.

31. (Currently Amended) A device for processing of at least one electronic message, the device comprising:

an e-mail client configured to receive at least one electronic message having a file attachment;

a user file system configured to store the file attachment in a file of a file system;

an attachment substitution unit configured to replace the file attachment of the received at least one electronic message with a memory location link in that at least one electronic message when user input requires the file attachment to be saved and linked in the file;

a display device configured to display the file attachment objects stored in the file of the file system after when the file is accessed by a user;

a message link insertion unit configured to insert a message link in the file of the file system when the user input requires the file attachment to be saved and linked such that the message link is displayed adjacent to the file attachment after the file is accessed by a user, the message link referring to the electronic message such that the electronic message is displayed after when the message link is actuated; and

a control unit configured to control the attachment substitution unit, the e-mail client and the message link insertion unit such that attachment substitution and message link insertion occurs automatically when the user input is provided to the device, unit.

REMARKS

A request for continued examination (RCE) is provided herewith along with the fee for the RCE. A petition for a one month extension of time and the fee for this extension of time are also provided herein.

As may be appreciated from the listing of claims provided above, the claims have been amended herein. Support for the amendment of the claims may at least be appreciated from Figure 3 and paragraphs 21 and 24-29 of the specification. These paragraphs correspond to paragraphs 27 and 29-35 in the published patent application for this application, which is U.S. Patent Application Publication No. 2006/0195526.

No additional fees are believed to be required for the present Amendment. Nevertheless, Authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. RESPONSE TO THE OBJECTION TO THE SPECIFICATION

The specification was objected to for not containing the term "objects" in the Office Action dated March 23, 2010 (hereafter "the Office Action") for not having antecedent basis for that term in the specification. Claim 31 was amended to remove the term "object." Therefore, the objection to the specification should be withdrawn.

II. RESPONSE TO THE REJECTION OF CLAIMS UNDER 35 U.S.C. § 112

Claims 13-15, 19-20 and 29 were rejected as being indefinite because of use of the term "the same file". (Office Action, at 2). These claims have been amended to resolve the antecedent basis issue. It is respectfully requested that the rejection of these claims under 35 U.S.C. § 112, second paragraph be withdrawn.

III. RESPONSE TO THE REJECTION OF CLAIMS ISSUED UNDER 35 U.S.C. § 103 IN THE OFFICE ACTION

Claims 12-17, 24-25 and 31 were rejected in the Office Action under 35 U.S.C. § 103 in view of Microsoft Outlook 2002 and the Windows XP OS system of October of 2001 (Office Action, at 3).

Claims 18-23 and 26-30 were rejected as obvious in view of Microsoft Outlook 2002, the Windows XP OS system of October of 2001 and Coppinger et al.

A. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight." MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because

the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 82 USPQ2d at 1396) (emphasis added).

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B. Claims 12-17 And 23-26 Are Allowable

Currently pending claim 12 requires a method for processing an electronic message to include opening an electronic message, saving at least one file attachment of the electronic message in a user-selected memory location, replacing the at least one file attachment in the electronic message with at least one first link when the at least one file attachment is saved, creating a second link to the electronic message when the at least one file attachment is saved, and saving the second link in the user-selected memory location where the file attachment is also stored when the at least one file attachment is saved. The first link is configured to display the at least one file attachment after the at least one first link is actuated. The second link is configured to display the electronic message after that second link is actuated. Claims 13-17 and 23-26 depend directly or indirectly from claim 12 and therefore also contain these limitations.

**1. The Cited Art Does Not Teach Or Suggest
The Creation Of A Link To An Electronic Message And Saving Of
That Link In A File In Which A File Attachment Is Saved When
That File Attachment Is Saved**

The Examiner has cited Microsoft Outlook 2002 and Windows XP as teaching and suggesting saving a link to an electronic message where an attachment file may be saved. (Office Action, at 3). However, the cited art does not teach or suggest all the limitations of the pending claims

Microsoft Outlook 2002 and XP do not teach or suggest any saving of an attachment and also creating a link to the electronic message that initially has such an attachment when the attachment is saved. For example, there is no "save as and link" command or functionality provided by Outlook 2002 and XP as noted in paragraphs 24-29 of the specification.

As may be appreciated from the screen shots of Figures 1-13 provided by the Examiner in the Office Action, a user must manually save an email to a desktop, then create a short cut link, then save the short cut link in the file in which an attachment is stored to be able to even save such a short cut in that file location by using Outlook 2002 and XP. There is no saving of an attachment while also creating and saving a link to the electronic message in the same file attachment that occurs when the attachment is saved.

Further, Coppinger et al. do not teach or suggest any message links or other links that refer to an electronic message nor the saving of such links in a file or other location in which an attachment from that electronic message is saved. In fact, the Examiner has correctly recognized that Coppinger only deals with attachments of electronic messages. (Office Action, at 7).

The cited art fails to teach or suggest all the limitations of claims 12-17 and 23-26. These claims are allowable over the cited art.

**2. The Examiner Has Failed To Show That
XP And Outlook Utilize The Claimed Method**

Further, the Examiner has failed to show that the claimed method has actually ever been used. The Examiner has argued that Microsoft XP and Outlook 2002 provide functionality that could permit the method to be practiced. However, none of the cited art teaches or suggests that such functionality be used. This is particularly true when there are so many steps required for a user to actually perform such a method using XP and Outlook.

The Examiner has not provided any evidence showing that the method of claims 12-17 and 24-25 has been taught or is used in the prior art. For example, no reference or other art relied on by the Examiner shows that the steps shown in Figures 1-12 in the Office Action were ever practiced in the prior art. The Examiner's rejection merely argues that such functionality *could* permit a user to practice the method of the previously presented claim 12.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981); MPEP § 2112.

Applicants understand the Examiner to argue that XP and Outlook inherently disclose the method of creating a link to an electronic message and saving that link in the same file as a file attachment of the electronic message is saved. However, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.¹ " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP 2112. At best, the Examiner has merely showed that a certain thing may result, not that is has resulted or was ever practiced. As found by the Federal Circuit in *In re Robertson*, and as stated in § 2112 of the MPEP, such evidence is insufficient to reject the pending claims.

For at least the above reasons, claims 12-17 and 23-26 are allowable over the cited art.

C. Claims 18-22 And 27-30 Are Allowable Over The Cited Art

Claim 18 is directed to a device that includes an attachment substitution unit that replaces a file attachment of a received electronic message with a memory location link after user input is received that requires the file attachment to be saved and linked. The device also includes a message link insertion unit that inserts a message link in a selected memory location when the file attachment is stored in the memory location in which the file attached to the electronic message is stored after the user input that requires the file attachment to be saved and linked is received. The message link refers to the electronic message. Claims 19-22 and 27-29 depend directly or indirectly from claim 18 and, therefore, also contain this limitation.

Claims 18-22 and 27-30 were rejected as obvious in view of Microsoft Outlook 2002, the Windows XP OS system of October of 2001 and Coppinger et al. (Office Action, at 6).

As noted above with reference to claim 8, the cited art fails to teach or suggest any user input that requires a file attachment to be saved and linked and also requires units to insert a message link in a selected memory location when that user input is received and a file attachment is saved in the memory location.

Microsoft Outlook 2002 and XP do not teach or suggest any saving of an attachment and also creating a link to the electronic message that initially has such an attachment when the attachment is saved. For example, there is no "save as and link" user input, command or functionality provided by Outlook 2002 and XP as noted in paragraphs 24-29 of the specification.

As may be appreciated from the screen shots of Figures 1-13 provided by the Examiner in the Office Action, a user must manually save an email to a desktop, then create a short cut link, then save the short cut link in the file in which an attachment is stored to be able to even save such a short cut in that file location by using Outlook 2002 and XP. There is no saving of an attachment while also creating and saving a link to the electronic message in the same file attachment that occurs when the attachment is saved.

Further, Coppinger et al. do not teach or suggest any message links or other links that refer to an electronic message nor the saving of such links in a file or other location in which an attachment from that electronic message is saved. In fact, the Examiner has correctly recognized that Coppinger only deals with attachments of electronic messages. (Office Action, at 7).

For at least the above reasons, the cited art do not teach or suggest each and every limitation of claims 18-22 and 27-30. Therefore, the cited combination of art cannot render these claims obvious

D. Claim 31 Is Allowable Over The Cited Art

Claim 31 is an independent claim and requires a device to include an attachment substitution unit that replaces a file attachment of a received electronic message with a memory location link when user input requires the file attachment to be saved and linked in the file. The

device also includes a message link insertion unit that inserts a message link in the file of the file system when the user input requires the file attachment to be saved and linked. The message link refers to the electronic message such that the message is displayed after the message link is actuated. The device also includes a control unit that controls the attachment substitution unit and message link insertion unit so that attachment substitution and message link insertion occurs automatically when the user input requiring the file attachment to be saved and linked is provided to the device.

The cited art does not teach or suggest any attachment substitution unit configured to replace the file attachment of any received electronic message. As noted above, the cited art does not teach or suggest any message link insertion unit that inserts a message link in a file that also has a file attachment of that message stored therein when user input requires the file attachment to be saved and linked. In fact, none of the cited art teaches or suggests any device to act on user input that requires both saving of an attachment and linking to occur.

**E. Granted European Patent No. EP 1 642 229
Shows The Pending Claims Are Allowable**

The present application corresponds to granted European Patent No. EP 1 642 229B1. For the Examiner's reference, a copy of this patent was provided to the Examiner with the Amendment dated October 28, 2009. The European Patent Office has found the invention disclosed in the present application to warrant patent protection and includes claims that are similar in scope to those pending in the present U.S. patent application. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

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Amendment dated July 22, 2010
Response to Office Action dated March 23, 2010

III. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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